



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Strange
8/6/03

Application No.: 09/602,923
Filing Date: June 23, 2000
Applicant: Bernard Duroux et al.
Group Art Unit: 2872
Examiner: Ricky D. Shafer
Title: EXTERIOR MIRROR FOR MOTOR VEHICLE
Attorney Docket: SCH-00039

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Commissioner for Patents
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APPEAL BRIEF

Dear Sir:

This is an Appeal Brief in response to the final Office Action mailed October 24, 2002. The Appeal Brief is submitted in triplicate.

The Commissioner is hereby authorized to charge any fees that may be required for filing a brief in support of an appeal in accordance with 37 C.F.R. 1.17(c), or credit any overpayment to Deposit Account No. 500906 (Schefenacker Vision Systems USA Inc.).

We are enclosing herewith a Petition for Extension of Time under 37 CFR 1.136(a), thereby extending the deadline for filing the appeal to July 24, 2003. If for some reason applicant has not requested a sufficient extension of time and/or has not

paid a sufficient fee necessary to prevent abandonment of this application, please consider this as a Request for an Extension for the required time period and/or authorization to charge Deposit Account No. 500906 for any extension of time fee which may be due.

TABLE OF CONTENTS

Real Party in Interest	1
Related Appeals and Interferences.....	1
Status of Claims.....	1
Status of Amendments.....	1
Summary of the Invention	1
Summary of the References Cited	2
Statement of the Issues Presented	4
Grouping of the Claims	4
Arguments Regarding the 35 U.S.C. 103(a) Rejection of Claims 1, 6 and 7.....	5
Arguments Regarding the 35 U.S.C. 103(a) Rejection of Claims 1-7	7
Conclusion	9
Appendix.....	10
Copy of the Claims Appealed	10

TABLE OF AUTHORITIES

Cases

<i>Uniroyal, Inc. v. Rudkin-Wiley Corp.</i> , 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).....	5
<i>In re Laskowski</i> , 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989).....	5
<i>In re Newell</i> , 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989).....	5
<i>In re Bond</i> , 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990)	5



Real Party in Interest

The real party in interest is Schefenacker Vision Systems France SA.

Related Appeals and Interferences

There are no related appeals or interferences.

Status of Claims

Claims 1-15 are currently pending in the instant application. Claims 8-15 have been previously withdrawn from consideration in the Office Action mailed March 28, 2002. In response to the amendment mailed June 28, 2002, claims 1-7 were finally rejected in the Office Action mailed October 24, 2002. A response to the final Office Action was mailed on January 24, 2003. An Advisory Action was mailed on February 5, 2003. This appeal is taken as to claims 1-7, as presently pending.

Status of Amendments

Although a response was filed in response to the final Office Action, none of the pending claims were amended at that time.

Summary of the Invention

An exterior rear view mirror (Page 1, line 23 - Page 6, line 16 and FIGS. 1-3) for a vehicle comprising a base (Page 1, lines 17-19 and Ref. 10 in FIG. 1) for mounting on a vehicle body, a housing (Page 1, lines 19-21 and Ref. 16 in FIG. 1) pivotally mounted on the base (Page 1, lines 17-19 and Ref. 10 in FIG. 1) for angular movement about a

first axis, a reflective member (Page 1, lines 22-25 and Ref. 18 in FIG. 1) mounted in the housing (Page 1, lines 19-21 and Ref. 16 in FIG. 1), an electric motor (Page 3, lines 4-7 and Ref. 34 in FIG. 2) having an output shaft (Page 3, lines 27-30 and Ref. 64 in FIG. 1) selectively operable to cause angular movement of the housing (Page 1, lines 19-21 and Ref. 16 in FIG. 1) about the first pivot axis (Page 2, lines 22-26 and Ref. 26) at a first discrete speed and at a second discrete speed (Page 1, line 30 - Page 2, line 6, and Page 3, line 36 - Page 6, line 16), and a controller (Page 3, line 36 - Page 6, line 16 and Ref. 70 in FIG. 3) adapted to control the electric motor (Page 3, lines 4-7 and Ref. 34 in FIG. 2) so as to selectively drive the housing (Page 1, lines 19-21 and Ref. 16 in FIG. 1) about the first axis (Page 2, lines 22-26 and Ref. 26) either at the first speed or at the second speed which is faster than the first speed (Page 1, line 30 - Page 2, line 6, and Page 3, line 36 - Page 6, line 16), is claimed.

Summary of the References Cited

It is the Applicants understanding that U.S. Patent No. 5,012,693 to Enomoto et al. appears to disclose a drive mechanism for an automatic rear-view mirror assembly of a motor-driven folding type. The driving mechanism includes an electric motor fixed on a mirror housing. The mirror housing is supported rotatably on a shaft fixed to a mirror base which is secured to a vehicle body in such a manner that it can be turned between a normal and retracted position by the drive mechanism. The drive mechanism includes a motor and a gear reducer composed of a plurality of planetary gear units. The planetary gear units include a sun gear connected to an output of the motor, and a group of transmission gears including a first spur gear mounted fixedly on the shaft and

a second spur gear connected to an output shaft and meshed with the first spur gear. The reduction gear includes a first casing which houses the planetary gear units on the same shaft and has a ring gear common to these planetary gear units, provided on its inner circumferential surface. The reduction gear also includes a second casing which houses the remaining planetary gear units on the same shaft as the planetary gear units of the first unit, so that the planetary gear units of both casings are meshed with each other. The second casing also has a ring gear on its inner circumferential surface and a bolt by which the first and second casings are combined unitarily with each other. The ring gears of the first and second casings are formed with different gear modules, with the ring gear of the first casing being formed with a smaller gear module than that of the ring gear in the second casing.

It is the Applicants understanding that U.S. Patent No. 6,204,753 to Schenk et al. appears to disclose a device for collision protection of projecting parts of motor vehicles having a controllable actuating mechanism at least for retracting and/or folding the projecting vehicle parts. At least one distance detection or proximity sensor, which is functionally connected to the actuating mechanism, is provided in the vehicle to detect the distance and/or the approach of an object with respect to the respective projecting vehicle part, and the actuating mechanism retracts or folds the respective vehicle part upon a detection signal delivered by the sensor and indicating a collision hazard with the object.

It is the Applicants understanding that Japanese Patent No. JP8026030 to Tomiyoshi appears to disclose a drive device of a motor-driven mirror for a vehicle by which the swing speed of a door mirror can be changed without remarkably changing a

customary circuit constitution. This drive device of a motor-driven mirror is provided with a plurality of motors M1, M1', for driving the motor-driven mirror, a drive changeover circuit 3 for driving changeover of the motors M1, M1', and a rectangular wave impressing circuit 10 for impressing rectangular waves R on the motors M1, M1', through the drive changeover circuit 3, and the rectangular wave impressing circuit 10 is provided with an adjusting means 27 adjusting the period width T of the rectangular wave R in order to control rotating speed of the motors M1, M1', so as to adjust the swing speed of the motor-driven mirror.

Statement of the Issues Presented

Are Applicant's claims to an exterior rear view mirror for a vehicle, as recited in claims 1, 6 and 7, unpatentable over U.S. Patent No. 5,012,693 to Enomoto et al. in view of Japanese Patent No. JP8026030 to Tomiyoshi or U.S. Patent No. 6,204,753 to Schenk et al.?

Are Applicant's claims to an exterior rear view mirror for a vehicle, as recited in claims 1-7, unpatentable over U.S. Patent No. 5,012,693 to Enomoto et al. in view of Japanese Patent No. JP8026030 to Tomiyoshi or U.S. Patent No. 6,204,753 to Schenk et al.?

Grouping of the Claims

For purposes of this appeal, claims 1-7 stand or fall together.

Arguments Regarding the 35 U.S.C. 103(a) Rejection Of Claims 1, 6 and 7

Claims 1, 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,012,693 to Enomoto et al. in view of Japanese Patent No. JP8026030 to Tomiyoshi or U.S. Patent No. 6,204,753 to Schenk et al.

The Applicants respectfully traverse the 35 U.S.C. §103(a) rejection of claims 1, 6 and 7.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

The law is also clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. §112 ¶ 4.

The Examiner correctly noted that Enomoto et al. fail to disclose that “the controller is adapted to control the electric motor in such a manner that the motor operates at a first discrete speed and at a second discrete speed.”

Apparently, the Examiner cited Tomiyoshi and Schenk et al. to cure the deficiencies in the teachings of Enomoto et al. However, neither Tomiyoshi nor Schenk et al. suggest that the housing is driven at two separate and discrete speeds, as presently claimed.

Tomiyoshi merely discloses that the swing speed of the motor-driven mirror can be adjusted. There is no mention of “swing speeds” which would indicate more than one speed being possible at a given time. Tomiyoshi only mentions that the rotating speed of the motors (not the mirror) can be adjusted. Thus, one of ordinary skill in the art would interpret that to mean that the motors, and thus the mirror, can be adjusted to rotate either slowly or rapidly or somewhere in between based on the settings, but that does not mean both slowly and rapidly at a given time, as the instantly claimed invention recites. Either the mirror disclosed by Tomiyoshi will rotate slowly or quickly, but not selectively both.

Schenk et al. also does not suggest a two-speed mirror adjustment system, wherein both speeds are determined by the movement of an output shaft of a motor. Schenk et al. merely discloses that the “rapid actuator 12” is in actuality a compressed spring that does not appear to be actuated by an output shaft of a motor. Therefore, one of ordinary skill in the art would not look to Schenk et al. for guidance on a two-speed mirror adjustment system, wherein both of the speeds are determined by the movement of an output shaft from a motor.

Accordingly, the Applicants submit that none of the cited references, either alone or in combination, render independent claim 1 obvious. Furthermore, dependent claims 6 and 7, are likewise allowable.

Arguments Regarding the 35 U.S.C. 103(a) Rejection Of Claims 1-7

Claims 1-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,953,167 to Valentino in view of Japanese Patent No. JP8026030 to Tomiyoshi or U.S. Patent No. 6,204,753 to Schenk et al.

The Applicants respectfully traverse the 35 U.S.C. §103(a) rejection of claims 1-7.

Again, the Examiner correctly noted that like Valentine, like Enomoto et al., fails to disclose that “the controller is adapted to control the electric motor in such a manner that the motor operates at a first discrete speed and at a second discrete speed.”

Apparently, the Examiner cited Tomiyoshi and Schenk et al. to cure the deficiencies in the teachings of Valentino. However, as previously noted, neither Tomiyoshi nor Schenk et al. suggest that the housing is driven at two separate and discrete speeds, as presently claimed.

Reiterating, Tomiyoshi merely discloses that the swing speed of the motor-driven mirror can be adjusted. There is no mention of “swing speeds” which would indicate more than one speed. Tomiyoshi only mentions that the rotating speed of the motors (not the mirror) can be adjusted. Thus, one of ordinary skill in the art would interpret that to mean that the motors and thus the mirror can be adjusted to rotate either slowly or rapidly or somewhere in between based on the settings, but that does not mean both

slowly and rapidly, as the instantly claimed invention recites. Either the mirror disclosed by Tomiyoshi will rotate slowly or quickly, but not selectively both.

Likewise, as previously noted, Schenk et al. also does not suggest a two-speed mirror adjustment system, wherein both speeds are determined by the movement of an output shaft of a motor. Schenk et al. merely discloses that the “rapid actuator 12” is in actuality a compressed spring that does not appear to be actuated by an output shaft of a motor. Therefore, one of ordinary skill in the art would not look to Schenk et al. for guidance on a two-speed mirror adjustment system, wherein both of the speeds are determined by the movement of an output shaft from a motor.

Accordingly, the Applicants submit that none of the cited references, either alone or in combination, render independent claim 1 obvious. Furthermore, dependent claims 2-7, are likewise allowable.

Conclusion

For the reasons advanced above, appellant respectfully urges that the rejection of claims 1-7 under 35 U.S.C. 103(a) is improper. Reversal of the rejection in this appeal is respectfully requested.

Respectfully submitted,

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Appendix

Copy of the Claims Appealed

1. An exterior rear view mirror for a vehicle comprising a base for mounting on a vehicle body, a housing pivotally mounted on the base for angular movement about a first axis, a reflective member mounted in the housing, an electric motor having an output shaft selectively operable to cause angular movement of the housing about the first pivot axis at a first discrete speed and at a second discrete speed, and a controller adapted to control the electric motor so as to selectively drive the housing about the first axis either at the first speed or at the second speed which is faster than the first speed.
2. An exterior rear view mirror according to claim 1, wherein the controller includes measuring means for determining the angle through which the housing has been moved.
3. An exterior rear view mirror according to claim 2, wherein the measuring means comprises a counter for counting the number of revolutions of the output shaft of the motor.
4. An exterior rear view mirror according to claim 3, wherein the second speed is at least five times as fast as the first speed.

5. An exterior rear view mirror according to claim 4, wherein the second speed is at least ten times as fast as the first speed.

6. An exterior rear view mirror according to claim 1, wherein the second speed is at least five times as fast as the first speed.

7. An exterior rear view mirror according to claim 6, wherein the second speed is at least ten times as fast as the first speed.